REMARKS

Claims 1-22 are pending in the application and all were rejected in the Office action mailed January 3, 2007. Claims 1 and 15 are independent claims. Claims 2-14, and 16-22 depend from independent claims 1 and 15, respectively.

Applicant respectfully requests reconsideration of pending claims 1-22, in view of the following remarks.

Rejection of Claims

Claims 1-22 were rejected under 35 U.S.C. 102(e) as being anticipated by O'Neill (US 6,832,373). The Applicant respectfully traverses the rejection.

With regard to the anticipation rejections, MPEP 2131 states, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California,* 814 F.2d 628, 631 2 USPQ2d 1051, 1053 (Fed.Cir. 1987). MPEP 2131 also states, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.,* 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

With regard to claim 1, the Applicant respectfully submits that the Office action has failed to show where O'Neill teaches or suggests, at least, "...a generator with a partial predictive mapping preprocessor...", as recited in Applicant's claim 1. The Office action alleges that figure 1C, element 102 discloses "...a generator with a partial predictive mapping preprocessor...". (Office action, page 3, lines 13-19) Applicant respectfully submits, however, that element 102 of figure 1C of O'Neill simply shows a box with the words "Update Generator", which teaches nothing with regard to a generator having "...a partial predictive mapping preprocessor...". Applicant respectfully submits that the Office action has failed to show where any other portions of the O'Neill disclosure teach anything with respect to "...a generator with a partial predictive mapping preprocessor...", as recited in Applicant's claim 1. Therefore, Applicant submits that the Office action has failed to

establish that O'Neill teaches each and every element of Applicant's claim 1, as required by M.P.E.P. §2131.

With regard to claim 15, the Applicant respectfully submits that the Office action has failed to show where O'Neill teaches or suggests, at least, "...creating a module map between modules in the old image and modules in the new image of firmware;...", "...creating a shift region list;...", and "...generating an update package using information at least based on the shift region list...", as recited in Applicant's claim 15. The Office action alleges that O'Neill, at column 4, lines 3-13 and column 10, lines 65-37 [sic, Applicant assumes lines 65-67], teaches "...creating a module map between modules in the old image and modules in the new image of firmware...". (Office action, page 7, lines 10-14)

According to O'Neill, column 3, line 63 to column 4, line 25:

"In one embodiment the invention comprises a system for updating a plurality of distributed electronic devices with an updated operating code comprising a first plurality of digital information sequences wherein each of the plurality of electronic devices include a resident operating code comprising a second plurality of digital information sequences that are stored within the electronic device. The system further comprises an update generator that compares an image of the first plurality of digital information sequences comprising the updated operating code to an image of the second plurality of digital information sequences comprising the resident operating code and identifies differences between of the updated operating code and the resident operating code and thereafter generates an update package comprising an instruction set which specifies how to generate the updated operating code utilizing at least a portion of the second plurality of digital information sequences of the resident operating code. The system further comprises a distribution system that distributes the update package to the electronic devices such that the update package is received by the

7

electronic devices and stored therein. The system further comprises a plurality of client modules that are respectively resident on each of the plurality of electronic devices, wherein the plurality of client modules access the distribution system and receive the update package and wherein the instruction set of the update package is executed by the client modules so as to generate the updated operating code by utilizing a least a portion of the second plurality of digital information sequences from the resident operating code."

(underlining added to show cited text)

According to O'Neill, column 10, line 65 to column 11, line 8:

"In many circumstances, operational software systems require periodic updates from older versions to newer versions. In addition, multiple updated versions of operational software may be required throughout the life of a client device for reasons of adapting to advances in computing technology. To satisfy these requirements, the update generator 102 generates update packages as newer versions of operational system software become available and then transfers the plurality of update packages to the update store 133 for storage and archiving in a memory or storage component."

(underlining added to show cited text)

Applicant respectfully submits that the underlined portions of O'Neill shown above and specifically cited in the Office action as teaching the feature "…creating a module map between modules in the old image and modules in the new image of firmware…." of Applicant's claim 15, fail to make any mention of "modules", "module map", and "firmware", let alone "…creating a module map between modules in the old image and modules in the new image of firmware….", as recited in Applicant's claim 15. Applicant respectfully

submits that the Office action has, therefore, failed to establish that O'Neill teaches or suggests this element of Applicant's invention, as required by M.P.E.P. §2131.

In addition, the Office action alleges that O'Neill, at column 4, lines 3-13, teaches "...creating a shift region list;...". (Office action, page 7, lines 10-17) Applicant respectfully submits that column 4, lines 3-13 of O'Neill, shown underlined above and specifically cited in the Office action as teaching the feature "...creating a shift region list;..." of Applicant's claim 15, fail to make any mention of anything related to "shifting", "regions", or "shift regions", let alone "...creating a shift region list;...", as recited in Applicant's claim 15. Therefore, Applicant respectfully submits that the Office action has failed to establish that O'Neill teaches or suggests this element of Applicant's invention, as required by M.P.E.P. §2131.

The Office action also alleges that O'Neill, at column 4, lines 3-13, teaches Applicant's claimed feature "...generating an update package using information at least based on the shift region list...". (Office action, page 7, lines 10-19) Applicant respectfully submits that column 4, lines 3-13 of O'Neill, shown underlined above and specifically cited in the Office action as teaching the feature "...generating an update package using information at least based on the shift region list..." of Applicant's claim 15, fail to make any mention of anything related to "shifting", "regions", or "shift regions", let alone "...generating an update package using information at least based on the shift region list...", as recited in Applicant's claim 15. Applicant respectfully submits, therefore, that the Office action has failed to establish that O'Neill teaches or suggests this element of Applicant's invention, as required by M.P.E.P. §2131.

Therefore, Applicant respectfully submits that the Office action has failed to show where the O'Neill reference teaches each and every element as set forth in Applicant's claims. Applicant respectfully submits that O'Neill is different from and fails to anticipate Applicant's invention as set forth in independent claims 1 and 15, for at least the reasons set forth above. The Applicant believes that claims 1 and 15 are allowable over O'Neill. Because claims 2-14 and 16-22 depend from independent claims 1 and 15, respectively, Applicant respectfully submits that claims 2-14 and 16-22 are also

allowable over O'Neill. The Applicant respectfully requests, therefore, that the rejection of claims 1-22 under 35 U.S.C. §102(e), be withdrawn.

Missing Foreign Reference

The Office action states, at page 2, that cited document "8202626" listed on the PTO-1449 form filed January 20, 2004 was not found in the Application. Applicant's representative respectfully submits that Applicant's records show that a copy of the missing reference, Japanese Public Patent Disclosure Bulletin No.: H08-202626 dated August 9, 1996, was included with the IDS filed January 20, 2004. Applicant has attached a duplicate copy of the missing document, along with copies of the Transmittal and PTO-1449 forms submitted on January 20, 2004, to this communication. A photocopy of the return postcard documenting the receipt at the USPTO of the four foreign references (including the allegedly missing reference), with the OIPE stamp showing date of receipt is also attached. Applicant respectfully requests entry of the duplicate copy of the H08-202626 reference into the record, as though received with the submission of January 20, 2004.

Conclusion

In general, the Office Action makes various statements regarding claims 1-22 and the cited references that are now moot in light of the above. Thus, Applicant will not address such statements at the present time. However, the Applicant expressly reserves the right to challenge such statements in the future should the need arise (e.g., if such statements should become relevant by appearing in a rejection of any current or future claim).

The Applicant believes that all of claims 1-22 are in condition for allowance. Should the Examiner disagree or have any questions regarding this submission, the Applicant invites the Examiner to contact the undersigned at (312) 775-8000 for an interview.
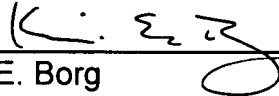
A Notice of Allowability is courteously solicited.

Respectfully submitted,

Date: May 3, 2007

Kevin E. Borg
Reg. No. 51,486

Hewlett-Packard Company
Intellectual Property Administration
Legal Department, M/S 35
P.O. Box 272400
Fort Collins, CO 80527-2400